

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After listing the claims as set forth above, claims 1-10 (10 claims) are now pending in this application.

Applicants filed a Preliminary Amendment A Prior to Action on May 31, 2001. In that amendment, a substitute specification was included, which, among other things, provided paragraph numbers and a new abstract. Also in the amendment, the Applicants amended claims 1-8 and added new claims 9 and 10. In the following remarks, Applicants will refer to the paragraph numbers of the substitute specification and to the claims as listed above.

The Office Action of July 7, 2003 and the references cited therein have been considered. In response to the rejections stated in the Office Action, Applicants provide the following comments. As demonstrated, however, each of the rejections is believed overcome, with the application being placed in condition for allowance. Accordingly, reconsideration and allowance of this application is respectfully requested.

On page 2, paragraph 1 of the Office Action, the Examiner only refers to 8 claims being presented for examination. Based on the previously filed Preliminary Amendment, 10 claims are pending in this application.

On page 2, paragraph 3 of the Office Action, the Examiner requires correction to the abstract, citing several errors that appeared in the original PCT specification. The above referenced Preliminary Amendment corrected the abstract which now complies with MPEP §608.01(b). Applicants respectfully request that the Examiner withdraw her comments about the abstract.

In the present application, there are pending six independent claims (1-4, 6, and 8). Also, claim 5 depends from independent claim 2, claim 9 depends from independent claim 3, claim 10 depends from independent claim 4, and claim 7 depends from independent claim 6.

On pages 2-9, paragraph 5 of the Office Action, the Examiner has rejected claims 1-8 under 35 U.S.C. §103(a) as being unpatentable over Akatsu, et al (USPN: 6,496,862) in view of Cassidy, et al (USPN: 6,249,883). Applicants believe that the Examiner's oversight of claims 9 and 10 (which depend from independent claims 3 and 4 respectively), would be covered by her comments, in rejecting claims 1-8 under 35 U.S.C. §103(a), therefore, Applicants' comments below should apply to all claims 1-10.

Akatsu discloses a communication and control technology in home entertainment systems (see col. 1, lines 27-30). More specifically, Akatsu states that the problem to be solved by his disclosure is "a need for a system to control and manage the expanding array of devices and services that can be connected and supported respectively, in IEEE 1394-based home entertainment system". (See col. 3, lines 26-30.)

Cassidy discloses a system and method that monitors networks for improving performance and methods for detecting instability in a system that includes a computer network. (See col. 1, lines 5-8.) Cassidy discloses and claims a method for predicting a failure in a computer network. (See claim 1, claim 34.)

The Examiner in her rejection of the claims under 35 U.S.C. §103(a) cites Akatsu as having that which is disclosed and claimed in the present application except "Akatsu does not explicitly teach the aforementioned information as used, when a change in the state of a component of the computer system has taken place, or is intended, to assess whether this results or would result in a change in terms of the availability of the aforementioned system function".

In response, Applicants submit that Akatsu is not analogous art. Akatsu discloses a home entertainment system 500 which functions through a home gateway 504 to provide a flexible reconfiguration when new or upgraded communication technology/hardware are connected to the home entertainment system. (See col. 7, lines 27-33.) Akatsu provides a

means for interfacing external input to the internal operation of the home entertainment system in accord with IEEE standard 1394. (See col. 4, lines 50-59.) As such, Applicants believe that one ordinarily skilled in the art of digital switching systems (see paragraph 2 present specification) would not be compelled to look at a home entertainment system as disclosed by Akatsu and suggested by the Examiner.

Cassidy, discloses methods for “predicting network failure” in a computer network. (See col. 5, lines 23-25.) In contrast, Applicants disclose and claim a method for monitoring availability of a system function in a computer system. Applicants submit that monitoring a specific function in a computer system is not the same as predicting network failure in a computer system as disclosed in Cassidy. Again, Applicants believe that one would not be compelled to look to Cassidy to monitor a specific function within a computer system since Cassidy is concerned with a complete network failure.

The Examiner believes that it would have been obvious to one of ordinary skill in the art to modify Akatsu by including that which is taught by Cassidy. However, the Examiner uses the language of the independent claims of the present application when citing Cassidy. Applicants submit that the independent claims do not discuss a network failure but rather discussed and claimed the “availability of a system function”.

Further, the Examiner cites that the reason for such combination is “the performance of the software as a whole can be optimized (See Cassidy, col. 1, lines 18-19)”. Applicants submit that the Examiner has mischaracterized that portion of Cassidy. The cited quote from Cassidy is a discussion of the prior art in the background of the Cassidy disclosure. It is not a statement of the problem to be solved by Cassidy, nor is it the problem stated to be solved by the present application. (See paragraphs 9 and 10 of the present specification.) Applicants traverse the Examiner’s suggested combination of Akatsu and Cassidy. Akatsu is not analogous art but is directed to a home entertainment system and Cassidy is directed to a complete computer network failure.

Applicants submit that one ordinarily skilled in the art would not look to Akatsu and Cassidy to obtain that which is disclosed and claimed in the present application which is directed to the monitoring the availability of a system function in a computer system.

Applicants submit that the Examiner is relying on hindsight in making the above obviousness rejections for the cited claims under 35 U.S.C. § 103(a). Applicants believe that the Examiner is basing her rejections on the mere identification in the prior art of individual components of claimed limitations in the present application. Specifically, the Examiner uses the language in the independent claims of the present application as justifying the use of Cassidy's disclosure with the non-analogous art of Akatsu.

The Examiner has not made any particular finding as to the reason a skilled artisan, with no knowledge of the claimed invention would have selected the components for a combination in the manner claimed in the present application. See, In re, Kotzab, 55 U.S.P.Q.2d 1313, 1317 (CAFC 2000) which also cites In re Dembiczak, 50 U.S.P.Q.2d 1614 (CAFC 1999). In re Dembiczak states "our case law makes clear that the best defense against subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for the showing of the teaching or motivation to combine prior references". Further, the Court states "combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the Inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight". Applicants believe that that is exactly what the Examiner has done in the present case.

As stated above, Applicants have pointed out the differences in structure or functionality or inoperabilities of the various elements cited by the Examiner and the various prior art patents combined by the Examiner in making her obviousness rejections. The Examiner has not made any showing of the teaching or instruction in the cited prior art to combine the elements from the cited prior art patents or addressed the incompatibility of such elements. Applicants submit that, as stated above, the claims as amended are patentably distinct from the prior art cited by the Examiner and that one ordinarily skilled in the art would not be compelled to combine the elements cited by the Examiner to obtain that which is disclosed and claimed in the present application.

Applicants also submit that the Examiner's prior art analysis, if the basis of the rejection is obviousness under 35 U.S.C. § 103(a), must include evidence relevant to the finding of whether there is a teaching, motivation or suggestion to select and combine the references relied on as evidence of obviousness. See In re Sang-su-Lee, 61 U.S.P.Q.2d 1430 (CAFC 2002). The Examiner has used language from the claims of the present application rather than pointing to a teaching or suggestion in the cited prior art references.

Applicants have attempted to respond to the several rejections of the claims to the extent necessary to correct any ambiguities cited by the Examiner and to address this prior art cited by the Examiner but with the intent of not limiting the scope of the invention protection accorded by the patent laws and these claims any further than absolutely necessary. It is respectfully submitted that each outstanding rejection has now been overcome and that each claim is in condition for allowance. Reconsideration under 37 C.F.R. § 1.111 and § 1.112 is respectfully requested.

The prior art cited, but not relied upon, has been reviewed. Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 10-3-03

FOLEY & LARDNER

Customer Number: 26371

Telephone: (414) 297-5776

Facsimile: (414) 297-4900

By James A. Wilke

James A. Wilke

Attorney for Applicant

Registration No. 34,279